

DOCKET NO.: JJO 0005

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:

Freeman et al.

Serial No.: 07/593,852

Group Art Unit: Unassigned

Filed: October 5, 1990

Examiner: Unassigned

U.S. Patent 5,088,484

For: Orthopedic Casting Bandage

Box Reissue
Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

DECLARATION AND POWER OF ATTORNEY
IN APPLICATION FOR REISSUE OF
FREEMAN ET. AL. U.S. PATENT 5,088,484

In accordance with the provisions of 35 USC §251 and 37 CFR §1.172(a), Johnson & Johnson Professional, Inc., a corporation of New Jersey, assignee of the entire interest in U.S. Patent 5,088,484, filed as Serial No. 07/593,852, on October 5, 1990, granted February 18, 1992 to the following inventors, both of whom are citizens of the United States of America:

Horace L. Freeman, whose residence is at 2217 Walker Avenue, Burlington, North Carolina 27215, and
Hee K. Yoon, whose residence is at 23 Cornerstone Drive, North Easton MA 02375,

hereby applies for and assents to reissue of said patent and declares as follows:

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1. The contents and claims of the attached specification have been reviewed and understood and it is believed that the said inventors are the original and first inventors of the subject matter which is claimed and for which a reissue of said patent is being sought.

2. The duty to disclose to the Office all information known to said assignee and said inventors to be material to patentability as defined in 37 CFR §1.56 is hereby acknowledged.

3. This reissue application does not seek to enlarge the scope of the claims of the original U.S. Patent 5,088,484.

4. It is verily believed that said original patent may be wholly or partly inoperative or invalid for the having claimed more than the inventors had a right to claim as explained in detail hereinafter.

5. Patent claim 1 presently reads as follows:

1. An orthopedic cast bandage comprising;
(a) an open mesh fibrous tape;
(b) a hardenable liquid resin coated on the fibrous tape and being capable of curing to form a hardened plastic; and
(c) at least one coloring agent visibly disposed on at least one portion of the fibrous tape, the coloring agent being stably retained by the fibrous tape while the tape is in a soft state in the presence of the hardenable liquid resin, wherein after the liquid resin becomes hard there is substantially no adverse effect on the coloring agent.

6. As can be seen from claim 1, and from claim 15 which is similarly worded, the limitation of the "hardenable liquid resin coated on the fibrous tape" is in paragraph (b)

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preceding the limitation of "at least one coloring agent visibly disposed on at least one portion of the fibrous tape" in paragraph (c). The order of the present wording can imply that the "hardenable liquid resin" is in fact coated on the tape prior to the disposing of the "coloring agent" on the tape. Likewise, it can imply that the claim is meant to cover both situations, i.e., whether the hardenable liquid is coated on the tape prior to or after the coloring agent is applied.

7. A reading of the specification of U.S. Patent 5,088,484, e.g., at column 4, lines 17-18, will reveal that the teaching of the invention is that the coloring agent is intended to be coated on the tape only prior to the application of the hardenable liquid layer.

8. The present patent claims 1 and 15, and those claims dependent thereon, can be read to be improperly claiming an "excess" insofar as they purport to cover an orthopedic cast bandage wherein the hardenable liquid resin is coated on the tape prior to the coloring agent being disposed on the tape

9. As present claims 1 and 15 are worded in the patent, it can be contended that they do not "particularly point out and distinctly claim" the subject matter that the inventors regard to be their invention as required by 35 USC §112, second paragraph. The proposed amendment herein to those claims puts

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them in conformity with the patent specification and eliminates the errors therein.

10. It is verily believed that the above-described errors arose without any deceptive intention on the part of patentees.

11. The errors are believed to have originally occurred at the time that the first claims were drafted and filed with application Serial No. 07/593,852 on October 5, 1990. An inspection of that application reveals that original claims 1 and 9 contain the same error and are subject to the same interpretation described hereinabove in paragraphs 6-9 for patent claims 1 and 15.

12. It is verily believed that the inventors and their attorney through error and without deceptive intent failed to recognize the errors and the potential interpretations of original application claims 1 and 9 and patent claims 1 and 15 as set forth in paragraph 6 above.

13. On September 29, 1994, a third-party Request for Reexamination Under 35 USC §§302-307 was filed by John R. Schiffhauer, Reg. No. 32,170, with service of copies on counsel for the patentees, requesting reexamination of U.S. Patent 5,088,484 on the grounds of alleged unpatentability of all claims in view of five references not of record in the file of said patent.

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14. Shortly after referral of the papers relating to the reexamination request to present counsel for assignee on October 7, 1994, a study was made of U.S. Patent 5,088,484, its claims, its prosecution file and cited art. At the time of that study, all patent claims were carefully analyzed by present counsel and the errors described above in paragraphs 6-9 herein were first noted. The decision was then made to correct said errors by this reissue of said patent.

15. Assignee hereby offers to surrender the original U.S. Patent 5,088,484 in accordance with 37 CFR §1.178.

POWER OF ATTORNEY

The undersigned, assignee of the entire interest in the above-identified application, hereby appoints Philip S. Johnson, Registration No. 27,200, and Francis A. Paintin, Registration No. 19,386, both of Philadelphia, Pennsylvania, as its attorneys with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the patent, and to transact all business in the Patent and Trademark Office connected therewith.

Send all future correspondence and address all telephone calls to:

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Francis A. Paintin
WOODCOCK WASHBURN KURTZ
MACKIEWICZ & NORRIS
One Liberty Place - 46th Floor
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(215) 568-3100

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued hereon.

CERTIFICATE UNDER 37 C.F.R. §3.73(b)

Johnson & Johnson Orthopaedics, Inc., New Brunswick, NJ,

certifies that it is the assignee of the entire right, title and interest in the patent application identified above by virtue of the following: an assignment from the inventor Horace L. Freeman to Carolina Narrow Fabric Company, which in turn assigned its entire interest to Johnson & Johnson Orthopaedics, Inc., recorded in the U.S. Patent and Trademark Office at Reel 6251, Frame 461; and an assignment from Coinventor Hee K. Yoon of his entire interest to Johnson & Johnson Orthopaedics, Inc., recorded in the U.S. Patent and Trademark Office at Reel 5773, Frame 972. On December 20, 1993, Johnson & Johnson Orthopaedics, Inc changed its name to Johnson & Johnson Professional, Inc. by a certificate

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of merger and change of name ; a copy of a document evidencing such change is enclosed herewith. of the patent application identified above. Assignee states that the evidentiary documents have been reviewed and certifies that, to the best of assignee's knowledge and belief, title is in the assignee taking action herein.

Johnson & Johnson Professional, Inc.

By Michael Q Tallow
Name:
Title: Assistant Secretary
Date: Nov-7, 1994